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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,498	09/01/2006	Isao Yako	107156-00345	2499
4372                      7590                      02/25/2009				
ARENT FOX LLP				
1050 CONNECTICUT AVENUE, N.W.				
SUITE 400				
WASHINGTON, DC 20036				
EXAMINER				
ADAMS, CARL				
ART UNIT		PAPER NUMBER		
2627				
NOTIFICATION DATE		DELIVERY MODE		
02/25/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com

IPMatters@arentfox.com

Patent\_Mail@arentfox.com

# Office Action Summary

**Application No.**

10/591,498

**Applicant(s)**

YAKO, ISAO

**Examiner**

CARL ADAMS

**Art Unit**

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 16-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 24-27 are drawn to a "computer program" *per se*, therefore, fail(s) to fall within a statutory category of invention.

A claim directed to a computer program itself is non-statutory because it is not:

A process occurring as a result of executing the program, or

A machine programmed to operate in accordance with the program, or

A manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality, or

A composition of matter.

See MPEP § 2106.01. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention,

which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 16-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US 6,396,874 B1).

6. In regards to claims 16, 20 and 24, Kato shows an information playback apparatus (1) (See Fig. 3 and Col. 9, lines 23-29), method and program (See Col. 10, lines 20-27) for playing back contents formed by including one or more data sets having a plurality of files (See Col. 10, lines 4-8) for storing presentation data (video and audio data) and having playback control data for managing contents of each of said files (See

Col. 10, lines 28-32), said information playback apparatus comprising: signal processing means (playback controller (8)) for performing a playback of said presentation data in accordance with control contents of said playback control data (See Fig. 3 and Col. 10, lines 47-53); abnormality detecting means (error correcting and coding unit (5)) for detecting whether there is an abnormality in said playback control data (See Fig. 3 and Col. 10, lines 63-65); and control means (error correcting and coding unit (5)) for, when said signal processing means is playing back said presentation data and once said abnormality detecting means detects an abnormality in said playback control data, detecting a data set to which the playback control data containing said abnormality belongs, and causing the signal processing means to perform a playback from the presentation data stored in an initial file belonging to the detected data set, without following said playback control data belonging to the detected data set (See Col. 10, lines 63-67 and Col. 10, lines 1-3).

7. In regards to claim 17, 21 and 25, Kato shows an information playback apparatus (1), (See Fig. 3 and Col. 9, lines 23-29) method and program (See Col. 10, lines 20-27) for playing back contents (video and audio data) formed by including one or more data sets having a plurality of files (See Col. 10, lines 4-8) and first playback control data for managing contents of each of said files (See Col. 10, lines 28-32), and including one or more data units in which said files have presentation data (video and audio data) and second playback control data (operating input) for managing contents of said presentation data (See Col. 11, lines 19-35), said information playback apparatus comprising: signal processing means (playback controller (8)) for performing

a playback of said presentation data in accordance with control contents of said first and second playback control data (See Fig. 3 and Col. 10, lines 47-53); abnormality detecting means (error correcting and coding unit (5)) for detecting whether there is an abnormality in said first and second playback control data (See Fig. 3 and Col. 10, lines 63-65); and control means (error correcting and coding unit (5)) for, when said signal processing means is playing back said presentation data and once said abnormality detecting means detects an abnormality in said first playback control data, detecting a data set to which the first playback control data containing said abnormality belongs, and causing the signal processing means to perform a playback from the presentation data stored in an initial file belonging to the detected data set, without following said playback control data belonging to the detected data set (See Col. 10, lines 63-67 and Col. 10, lines 1-3), and for, when said signal processing means is playing back said presentation data and once said abnormality detecting means detects an abnormality in said second playback control data, detecting a data unit to which the second playback control data containing said abnormality belongs, and causing the signal processing means to continue the playback from the presentation data belonging to the detected data unit, without following said playback control data belonging to the detected data unit (See Col. 11, lines 19-35, Col. 10, lines 63-67 and Col. 10, lines 1-3).

8. In regards to claims 18, 22 and 26, Kato shows that said contents are recorded in a storage medium (optical disc (2)) (See Fig. 3 and Col. 9, lines 23-29).

9. In regards to claim 19, 23 and 27, Kato shows that said contents are supplied through transmission media (readout unit (3)) (See Col. 9, lines 30-34).

### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL ADAMS whose telephone number is (571)270-7448. The examiner can normally be reached on Monday through Friday, 8:00 AM to 5:00 PM, alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571)-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Adams/  
Examiner, Art Unit 2627

/Wayne Young/  
Supervisory Patent Examiner, Art Unit 2627